



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,811	02/04/2002	Thomas E. Ward III	IS/074 Cont. 4	6065
75563	7590	03/16/2011		
ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704			EXAMINER PENG, FRED H	
			ART UNIT 2426	PAPER NUMBER
			NOTIFICATION DATE 03/16/2011	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPatentMail@ropesgray.com  
USPatentMail2@ropesgray.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/066,811	<b>Applicant(s)</b> WARD ET AL.	
	<b>Examiner</b> FRED PENG	<b>Art Unit</b> 2426	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26,31-58 and 60-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26,31-58 and 60-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/17/2010</u> .  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 2426

### **DETAILED ACTION**

1. This Office Action is in response to an AMENDMENT entered 12/17/2010.
2. The non-final Office Action mailed 07/07/2010 is incorporated as this final Office Action.

### ***Status of Claims***

3. Claims 1-26, 31-58 and 60-65 are pending in this application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-23, 26, 31-58 and 62-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (US 2003/0005445) in view of Ellis et al (US 2008/0184315).

Regarding Claims 1, 39 and 57, Schein discloses a system (FIG.1, FIG.16A) with corresponding method and a computer readable medium (FIG.1, 18) having stored thereon a set of instructions for displaying an advertisement (FIG.16A, 524, 526, 528), when executed by a microprocessor (FIG.1, 16), cause the microprocessor to perform the step of:

storing, local to a user equipment, viewer profile information in a first database (Para 109; viewing history);

receiving advertisement information and stored in second database; the advertisement including primary advertisement information; a processor configured to retrieve the stored

Art Unit: 2426

advertisement from the second database and display the advertisement (Para 7 lines 1-5; Para 50; such as a broadcast commercial).

Schein is silent about determining, based on the retrieved advertisement and the stored viewer profile information, supplemental advertisement information; and

customize, local to the user equipment, the retrieved advertisement to include the supplemental advertisement information to form a customized advertisement; and a display screen configured to display the customized advertisement, wherein the displayed customized advertisement includes both the primary and the supplemental advertisement information.

In an analogous art, Ellis discloses in a preferred embodiment, the currently-tuned television signal comprises a commercial advertisement and the product or service available is associated with the commercial... For example, in the simplest embodiment, only a single product, i.e., a product brochure, may be available. In this case, the microcontroller 16 may be configured to cause the video overlay device 25 to display a standard on-screen message such as "Press \* to receive a brochure describing this product." This embodiment assumes that the user has previously provided his name and address or that the information is extracted from the program services billing system (Para 230).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Schein's system to include supplemental advertisement information, as taught by Ellis, to take advantage of targeting the specific viewers; thereby improve advertising effectiveness.

Regarding Claim 2, Schein in view of Ellis disclose the receiving, determining, customizing, and displaying steps are performed in substantially real time (Para 230; customize the broadcast commercial is substantially real time).

Regarding Claims 3, 13, 14 and 49-50, Schein further discloses promotional information about a future TV program or product is a video preview (Para 129; Para 133 lines 21-23).

Art Unit: 2426

Regarding Claims 4, 5 and 40-42, Schein further discloses promotional info about a currently telecast and future TV program, and products and service (Para 129, Para 133 lines 21-25).

Regarding Claims 6 and 43, Schein discloses storing favor program guide information and respective advertisements for display. Therefore, Schein inherently discloses combining a portion of the received advertisement with stored favor channel information (FIG.16A, 524, 528; Para 109-111; as the favor program guide including the corresponding favorite channels and programs such as a guide shown in FIG.16A).

Regarding Claims 7 and 44, Schein further discloses storing a favor program information and combining a portion of the received advertisement with stored favor program information (FIG.16A, 524, 528; Para 109-111, especially Para 109 lines 1-7; user is able to customize a favorite program list with advertisement such as a guide shown in FIG.16A).

Regarding Claims 8, 16, 45 and 52, Schein further discloses storing a web site address and combining a portion of the received advertisement with stored a web site address and activating a function comprising linking to a web site based on an address related to the selected info and displaying more info from the web sites (Para 139 lines 1-11, Para 144 lines 8-12).

Regarding Claims 9 and 46, Schein is not clear about storing an info related to a geographical location and may be used to combine a portion of the received advertisement with the info related to a geographical location.

In an analogous art, Ellis discloses storing an info related to a geographical location and may be used to combine a portion of the received advertisement with the info related to a geographical location (Para 230, a viewer's address).

Art Unit: 2426

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Schein's system to include advertisement with the info related to a geographical location, as taught by Ellis to target individual viewers.

Regarding Claims 10 and 47, Schein further discloses storing info related to a TV viewer and combining a portion of the received advertisement with the info related to a TV viewer (Para 128).

Regarding Claims 11, 12 and 48, Schein also discloses the 1st database includes info related to rotating ad info in the EPG for combining a portion of ad data with the stored info related to rotating ad info and further display the advertisement info in the EPG based on the rotating advertisement info (FIG.16A, Para 134 lines 4-9).

Regarding Claims 15, 17, 51 and 53, Schein further discloses steps of selecting the displayed info using a pointing device and activating a function related to the selected info and display more detail info related to the selected info and selected advertisement (FIG.1, 40; Para 95; Para 133).

Regarding Claims 18, 19 and 54, Schein further discloses step of activating a function comprising scheduling future and currently telecast TV program for recording (FIG.11, 230; FIG.18A; FIG.19A; Para 96).

Regarding Claims 20 and 58, Schein is not clear about overlaying, at a user equipment, the supplemental advertisement information onto the retrieved advertisement to form a customized advertisement and displaying the customized advertisement on the display, wherein the customized advertisement includes both the primary advertisement information and the overlaid supplemental advertisement information.

Art Unit: 2426

In an analogous art, Ellis discloses overlaying, at a user equipment, the supplemental advertisement information onto the retrieved advertisement to form a customized advertisement and displaying the customized advertisement on the display, wherein the customized advertisement includes both the primary advertisement information and the overlaid supplemental advertisement information (Para 230; especially lines 22-26)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Schein's system to overlay the supplemental advertisement information, as taught by Ellis, to take advantage of targeting the specific viewers; thereby improve advertising effectiveness.

Regarding Claims 21-23, Schein further discloses promotional info about a currently telecast and future TV program, and products and service (Para 129; Para 133 lines 21-25).

Regarding Claims 26 and 34, Schein is not clear about overlaying an icon to access the products from a website for more information.

In an analogous art, Ellis teaches overlaying an icon to access the products for more information (Para 230); furthermore using an icon to link to a website to get more information such as product is well known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to a link to a web site, to take advantage of internet technology to access more information.

Regarding Claims 31 and 32, Schein further discloses promotional information about a future TV program or product is a video preview (Para 129; Para 133 lines 21-23).

Art Unit: 2426

Regarding Claim 33, Schein further discloses the steps of selecting the displayed advertisement using a pointing device and activating a function related to the selected advertisement (FIG.1, 40).

Regarding Claim 35, Schein further discloses the steps of activating a function comprising more detail info related to the selected advertisement (Para 127 lines 1-6).

Regarding Claim 36, Schein further discloses the steps of activating a function comprising displaying a video preview related to the selected advertisement (Para133 lines 21-26).

Regarding Claim 37, Schein further discloses step of activating a function comprising scheduling future and currently telecast TV program for recording (Para 96).

Regarding Claim 38, Schein further discloses the steps of activating a function comprising tuning to a currently telecast television program (Para 96).

Regarding Claim 55, Schein further discloses the steps of activating a function comprising tuning to a currently telecast television program (Para 96).

Regarding Claim 56, Schein further discloses promotional information about a future TV program or product is a video preview (Para 129, Para 133 lines 21-23).

Regarding Claims 62, Schein further discloses the customized advertisement is displayed on a first portion of the display (FIG.16A, 524, 526 or 528 for customized advertisement) and television schedule information is displayed on a second, non-overlapping, portion of the display (FIG.16A, 508; program matrix of cells including program schedule information).



Regarding Claims 63, Schein further discloses the customized advertisement is displayed on a first portion of the display (FIG.16A, 524, 526 or 528 for customized advertisement) and a video is displayed on a second, non-overlapping, portion of the display (FIG.16A, 526; to display the selected program).

Regarding Claims 64, Schein is not clear about displaying the primary advertisement information in one portion and the supplemental information in another portion.

In an analogous art, Ellis discloses, in one embodiment, the primary advertisement information is displayed on a first portion of the display (FIG.9, HBO program Shaker Run), and the supplemental advertisement information is displayed on a second, non-overlapping, portion of the display (FIG.9, HBO order message).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to display the primary advertisement information in one portion and the supplemental information in another portion as an engineering choice.

Regarding Claims 65, Schein is not clear about the primary advertisement information is displayed on a first portion of the display, and the supplemental advertisement information is displayed on a second portion of the display; wherein the second portion of the display overlaps at least partially with the first portion of the display

In an analogous art, Ellis discloses the primary advertisement information is displayed on a first portion of the display, and the supplemental advertisement information is displayed on a second portion of the display; wherein the second portion of the display overlaps at least partially with the first portion of the display (Para 230; the supplemental advertisement information in one portion of the display overlays the primary advertisement in another portion of the display).

Art Unit: 2426

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to overlay the supplemental advertisement information over the primary advertisement information as an engineering choice.

5. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (US 2003/0005445) and Ellis et al (US 2008/0184315) as applied to claim 20 above, and further in view of Coleman et al (US 5,844,620).

Regarding Claims 24 and 25, Schein discloses storing and displaying a favor program listing but is silent about overlaying the stored favor channel/program information onto a portion of the stored advertisement information.

In an analogous art, Coleman discloses overlaying the stored program guide information onto a portion of a programming which could be an advertisement to search for new channels or programs (FIG.6; Col 5 lines 22-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Schein and Ellis to include overlaying the stored favor channel/program listing onto a portion of the stored advertisement information, without interruption of existing programming while look for favor new channels/programs.

6. Claims 60 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (US 2003/0005445) and Ellis et al (US 2008/0184315) as applied to claim 1 above, and further in view of Esch et al (US 5,099,319).

Regarding Claim 60, Esch discloses allowing customized television commercials by adding text in any language (Col 3 lines 45-51). Therefore, a person of ordinary skill in the art would have had good reason to pursue the known options to replace the original text with

Art Unit: 2426

customized text to target the certain group. It would require no more than "ordinary skill and common sense," to replace the original text with customized text to achieve targeting purpose.

Regarding Claim 61, Esch also discloses adding graphics to customize a commercial (Col 3 lines 45-51). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace a graphical portion of the received advertisement information with a graphic portion of the supplemental advertisement information to take advantage of graphical form to customize an advertisement for targeted group as an engineering choice or known options to try as common sense.

### ***Response to Arguments***

7. Applicant's arguments filed 12/17/2010 have been fully considered but they are not persuasive.

#### **In reference to Applicant's arguments**

However, even assuming that this interpretation is correct, disclosure still cannot be found in the cited portion of Ellis for determining the message (i.e., the alleged supplemental advertisement information") based on the user's name and address" (i.e., the alleged viewer profile information), as in applicants' claims. Instead, the portion of Ellis cited by the Examiner describes that the user's name and address" are accessed or obtained after the displayed message" is selected by a user, and so it follows that the initial display of the message" is independent of the user's name and address." In contrast, applicants' claims describe determining supplemental advertisement information based on viewer profile information.

#### **Examiner's response**

The Examiner respectfully disagrees. The cited portion of " Alternatively, the user may simply request to be placed on a mailing list to receive additional information about the product or service being advertised as well as other related products and services" earlier in the Para 228 along with the cited portion of "...in this case, the microcontroller 16 may be configured to cause

Art Unit: 2426

the video overlay device 25 to display a standard on-screen message such as "Press \* to receive a brochure describing this product." This embodiment assumes that the user has previously provided his name and address or that the information is extracted from the program services billing system" clearly shows that the on-screen message, as a supplemental advertisement information is only sent to the users who have provided their name and address information earlier. Thus the cited portions from the above read on the claimed limitation of determining supplemental advertisement information based on viewer profile information.

### ***Conclusion***

8. Claims 1-26, 31-58 and 60-65 are rejected.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Correspondence Information***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRED PENG whose telephone number is (571)270-1147. The examiner can normally be reached on Monday-Friday 09:30-19:30.

Art Unit: 2426

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hirl can be reached on (571) 272-3685. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fred Peng/

Examiner, Art Unit 2426

/Joseph P. Hirl/

Supervisory Patent Examiner, Art Unit 2426

March 12, 2011